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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)
Daniela GIACCHETTI et al.) Group Art Unit: 3628
Application No.: 10/024,622) Examiner: Borissov, Igor N.
Filed: December 21, 2001) Confirmation No.: 3918
For: HISTORICAL BEAUTY RECORD)

Attention: Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Appellants submit this Reply Brief under 37 C.F.R. § 41.41 to the Board of Patent Appeals and Interferences ("the Board"), in response to the October 9, 2007 Examiner's Answer ("Examiner's Answer") in this case.

I. ARGUMENT

The Examiner has altered his arguments in a manner that differs from his prior assertions in this case, particularly with regard to the § 101 rejection of claims 1-25 and 27-61, the §102(e) rejection of claim 31, and the § 103 rejection of claim 50. Appellant respectfully submits the following remarks in response to the Examiner's new arguments.

A. The § 101 Rejection of Claims 1-25 and 27-61 Should Be Reversed.

1. Claims 1-4 and 53

a) Claim 1

The Examiner alleges that claim 1 is purportedly directed to non-statutory subject matter because “[m]ethod claim 1 does not recite any electrical, chemical, or mechanical acts or results, typical in traditional process claims; the claim does not require any machine or apparatus to perform the recited steps; and finally the claim does not provide any physical transformation of an article to a different state or thing, nor does it require any transformation of data or signals.” Examiner's Answer at 25. The Examiner also alleges that “the claim is so broad that it is directed to the abstract idea itself, rather than its practical implementation.” *Id.* Appellants respectfully disagree.

Appellants submit that independent claim 1 is, in fact, directed to statutory subject matter under 35 U.S.C. § 101. The Examiner continues to misconstrue the terms “facilitating” and “enabling,” recited in claim 1. The Examiner correctly identifies explanations of these terms in Appellants' specification, yet fails to appreciate their significance. Appellants' specification notes that, with respect to step 202 of FIG. 2A,

“[f]acilitating storage may include **acts** of directly storing of the usage information or may include the indirect **acts** of providing direction or tools to another party, such as the subject, for saving and/or maintaining the information.” Page 8, lines 18-20 (emphasis added).

The specification further explains that “[e]nabling’ [and] ‘facilitating’ . . . refer to one or more of a direct act of performing the action, and any indirect act of encouraging or being an accessory to the action.” Page 32, lines 9-11. “Thus, the terms include partnering or cooperating with an entity who performs the action and/or referring commerce to or having commerce referred from an entity who performs the action.” Page 32, lines 11-13. Indirect activity “may include providing a subject with one or more of tools to knowingly aid in performing the action [where the t]ools may include software, hardware, or access (either directly, through hyperlink, or some other type of cooperation or partnering) to a network location (e.g., web site) providing tools to aid in performing the action.” Page 32, lines 13-22.

Appellants respectfully point out that, as emphasized above, the definitions provided in the specification for both “facilitating” and “enabling” clarify that these terms involve **acts**, regardless of whether they constitute direct or indirect acts. Therefore, the method of independent claim 1 is more than a mere algorithm, abstract idea, or mental process, and thus directed to statutory subject matter. Accordingly, the § 101 rejection of claim 1 should be reversed.

b) Claims 2-4 and 53

Claims 2-4 and 53 depend from independent claim 1. Claims 2-4 and 53 are directed to statutory subject matter for reasons similar to the ones discussed above with

respect to independent claim 1. Accordingly, the § 101 rejection of claims 2-4 and 53 should be reversed.

Furthermore, even if claim 1 were directed to non-statutory subject matter, a notion that Appellants dispute, the dependent claims recite features that do not have any alleged § 101 deficiencies.

i) Claim 4

Claim 4 further recites “obtaining . . . first information and obtaining . . . second information occurs over a network and at a location remote from [a] subject.” One skilled in the art reviewing claim 4 would understand that the recited steps involve electrical acts or results and require machines or apparatus to perform them. For these additional reasons, claim 4 is directed to statutory subject matter. Accordingly, the § 101 rejection of claim 4 should be reversed.

2. Claims 5-25, 27-30, and 54-56

a) *Claim 5*

Independent claim 5 recites, among other things, “facilitating **electronic capture** of a first image of an external body condition of a subject” and “facilitating, after the subject has used the at least one beauty product, **electronic capture** of a second image of the external body condition of the subject” (emphasis added). The Examiner alleges that “the claim does not require any transformation of said captured data, nor does it require physical transformation of an article to a different state or thing.” Examiner’s Answer at 26. The Examiner also asserts that “without requiring any machine or apparatus to perform the recited steps, or implementing a mathematical formula or algorithm to transform data, claim 5 does not represent a real world activity

such as found in *Arrhythmia*, *Alappat*, or *State Street*.” Examiner’s Answer at 27.

Appellants respectfully disagree.

Appellants submit that the electronic capture of a first and second images of an external body condition involves transformation of an optical view of an external body condition into an electronic representation (image) of the external body condition. The transformation involves electrical acts or results and requires a machine or apparatus to perform it. Thus, independent claim 5 is directed to statutory subject matter.

Accordingly, the § 101 rejection of claim 5 should be reversed.

b) Claims 6-25, 27-30, and 54-56

Claims 6-25, 27-30, and 54-56 depend from independent claim 5. Claims 6-25, 27-30, and 54-56 are directed to statutory subject matter for reasons similar to the ones discussed above with respect to independent claim 5. Accordingly, the § 101 rejection of claims 6-25, 27-30, and 54-56 should be reversed.

Furthermore, even if claim 5 were directed to non-statutory subject matter, a notion that Appellants dispute, the dependent claims recite features that do not have any alleged § 101 deficiencies.

i) Claim 11

Claim 11 further recites “enabling electronic capture of at least one of the first and second first images includes providing access, via a network, to image capture and management software.” One skilled in the art reviewing claim 11 would understand that the recited steps involve electrical acts or results and require machines or apparatus to perform them. For these additional reasons, claim 11 is directed to statutory subject matter. Accordingly, the § 101 rejection of claim 11 should be reversed.

ii) Claim 17

Claim 17 further recites that “the differences are electronically ascertained using an image processing comparison between the first and second image.” One skilled in the art reviewing claim 17 would understand that the recited steps involve electrical acts or results and require machines or apparatus to perform them. For these additional reasons, claim 17 is directed to statutory subject matter. Accordingly, the § 101 rejection of claim 17 should be reversed.

iii) Claim 20

Claim 20 further recites that “the electronic image capture device is at least one of a digital still camera, a digital video camera, a scanner, and a web cam.” One skilled in the art reviewing claim 20 would understand that the recited steps involve electrical acts or results and require machines or apparatus to perform them. For these additional reasons, claim 20 is directed to statutory subject matter. Accordingly, the § 101 rejection of claim 20 should be reversed.

3. Claims 31, 39-43, 45, 48, 50-52, and 58

The Examiner alleges that “the [step] of: ‘*storing information*’ or ‘*providing instructions for storage of the information*’ does not require any transformation of data, nor does it require physical transformation of an article to be a different state or thing.” Examiner’s Answer at 27. Appellants respectfully disagree.

a) *Claim 31*

Independent claim 31 recites features that are similar to the features recited in independent claim 5. For example, claim 31 recites, among other things, “capturing, through a beauty facility, at least a first image of an external condition of a subject” and

“capturing, through the beauty facility, at least a second image of the external condition of the subject, the second image being captured after the first image is captured.” For reasons similar to those set forth with respect to independent claim 5, claim 31 is directed to statutory subject matter. Accordingly, the § 101 rejection of claim 31 should be reversed.

b) Claim 39

Independent claim 39 recites, among other things, “enabling a plurality of beauty facilities to read the information on the transportable medium, and to update the information when the subject visits one or more of the plurality of beauty facilities; and enabling the personal information to be updated by the subject at a location remote from a beauty facility.” Appellants submit that the personal beauty information is recorded in a transportable medium in a machine readable format, such as in binary. The subject may not understand the information without the aid of a machine or apparatus. Thus, reading the information on the transportable medium and updating the information on the medium by the subject requires transformation of the information and a machine or apparatus. For at least these reasons, claim 39 is directed to statutory subject matter. Accordingly, the § 101 rejection of claim 39 should be reversed.

c) Claim 45

Independent claim 45 recites, among other things, “enabling an individual to record in a data structure information . . .” and “enabling an individual to update in the data structure [the] information” Appellants submit that information recorded in a data structure is in a format and/or structure not understandable by a subject without the aid of a machine or apparatus. Thus, recording and updating information in a data

structure requires transformation of the information in accordance with rules or structures enforced by the data structure. For at least these reasons, claim 45 is directed to statutory subject matter. Accordingly, the § 101 rejection of claim 45 should be reversed.

d) Claim 48

Independent claim 48 recites features that are similar to the features recited in independent claim 5. For example, claim 48 recites, among other things, “facilitating electronic capture of a first image of an external body condition of a subject” and “facilitating, after the subject has used the at least one cosmetic product, electronic capture of a second image of the external body condition of the subject” For reasons similar to those set forth with respect to independent claim 5, claim 48 is directed to statutory subject matter. Accordingly, the § 101 rejection of claim 48 should be reversed.

e) Claim 50

Independent claim 50 recites features that are similar to the features recited in independent claim 39. For reasons similar to those set forth with respect to claim 39, claim 50 is directed to statutory subject matter. Accordingly, the § 101 rejection of claim 50 should be reversed.

f) Claims 40-43 and 58

Claims 40-43 and 58 depend from independent claim 39. Claims 40-43 and 58 are directed to statutory subject matter for reasons similar to the ones discussed above with respect to claim 39. Accordingly, the § 101 rejection of claims 40-43 and 58 should be reversed.

Furthermore, even if claim 39 were directed to non-statutory subject matter, a notion that Appellants dispute, the dependent claims recite features that do not have the alleged § 101 deficiencies.

i) Claim 40

Claim 40 further recites that “the remote update is enabled, at least in part, by information exchanges initiated by the subject over an electronic network.” One skilled in the art reviewing claim 40 would understand that the recited steps involve electrical acts or results and require machines or apparatus to perform them. For these additional reasons, claim 40 is directed to statutory subject matter. Accordingly, the § 101 rejection of claim 40 should be reversed.

ii) Claim 42

Claim 42 further recites that “the transportable medium includes at least one of magnetic storage medium, optical disc, flash memory devices, or other tangible media upon which information may be recorded.” One skilled in the art reviewing claim 42 would understand that the recited steps involve electrical acts or results and require machines or apparatus to perform them. For these additional reasons, claim 42 is directed to statutory subject matter. Accordingly, the § 101 rejection of claims 42 should be reversed.

iii) Claim 43

Claim 43 further recites that “the personal information stored on the transportable medium include time lapse images of portions of the subject’s body” and that “the subject is enabled to auto-evaluate visible changes over time, and to record the auto-evaluated visible changes on the transportable media.” One skilled in the art reviewing

claim 43 would understand that the recited steps involve electrical acts or results and require machines or apparatus to perform them. For these additional reasons, claim 43 is directed to statutory subject matter. Accordingly, the § 101 rejection of claim 43 should be reversed.

g) Claims 51 and 52

Claims 51 and 52 depend from independent claim 50. Claims 51 and 52 are directed to statutory subject matter for reasons similar to the ones discussed above with respect to claim 50. Accordingly, the § 101 rejection of claims 51 and 52 should be reversed.

Furthermore, even if claim 50 were directed to non-statutory subject matter, a notion that Appellants dispute, the dependent claims recite features that do not have the alleged § 101 deficiencies.

i) Claim 52

Claim 52 further recites that “the location is a portable information storage medium.” As explained above with respect to claim 39, storing information in a portable information storage medium requires transformation of the information and a machine or apparatus. For these additional reasons, claim 52 is directed to statutory subject matter. Accordingly, the § 101 rejection of claim 52 should be reversed.

4. Claims 32-38 and 57

The Examiner alleges that “the step of: *‘providing a beauty facility with technology for capturing external body condition images of a customer’* could be understood as merely providing a beauty consultant with a digital camera; and the step of: *‘instructing the beauty facility to capture images of the external body condition before*

and after application of the at least one cosmetic product,' could be understood as explaining the beauty consultant [*sic*] how to use the digital camera.” Examiner’s Answer at 27.

a) Claim 32

Appellants submit that independent claim 32 further recites the step of “distributing at least one cosmetic product to [a] beauty facility,” and the step involves at least mechanical, if not also electrical, acts or results. The specification also provides that the term “distribute” includes “one or more of manufacturing, advertising, reselling, wholesaling, selling, offering for sale, or providing information on . . . beauty products.” Page 9, lines 17-19. The term also includes “advertis[ing] a product via an electronic channel of commerce, or . . . provid[ing] a hyperlink to a [Web]site that advertises or offers for sale a product.” Page 9, lines 19-21.

For at least the reasons set forth above, independent claim 32 is directed to statutory subject matter. Accordingly, the § 101 rejection of claim 32 should be reversed.

b) Claim 33-38 and 57

Claims 33-38 and 57 depend from independent claim 32. Claims 33-38 and 57 are directed to statutory subject matter for reasons similar to the ones discussed above with respect to independent claim 32. Accordingly, the § 101 rejection of claims 33-38 and 57 should be reversed.

Furthermore, even if claim 32 were directed to non-statutory subject matter, a notion that Appellants dispute, the dependent claims recite features that do not have the alleged § 101 deficiencies.

i) Claim 33

Claim 33 further recites “instructing the beauty facility to capture images includes instructing the beauty facility on how to record images on a transportable medium.”

One skilled in the art reviewing claim 33 would understand that the recited steps involve electrical acts or results and require machines or apparatus to perform them. For these additional reasons, claim 33 is directed to statutory subject matter. Accordingly, the § 101 rejection of claim 33 should be reversed.

ii) Claim 34

Claim 34 further recites “providing the customer with software that enables the customer to view the images at a location remote from the beauty facility.” One skilled in the art reviewing claim 34 would understand that the recited steps involve electrical acts or results and require machines or apparatus to perform them. For these additional reasons, claim 34 is directed to statutory subject matter. Accordingly, the § 101 rejection of claim 34 should be reversed.

iii) Claim 35

Claim 35 further recites that “providing the customer with software, includes providing the customer with access to a web site through which the images are viewable.” One skilled in the art reviewing claim 35 would understand that the recited steps involve electrical acts or results and require machines or apparatus to perform them. For these additional reasons, claim 35 is directed to statutory subject matter. Accordingly, the § 101 rejection of claim 35 should be reversed.

iv) Claim 37

Claim 37 further recites “enabling the customer to capture images to the transportable medium at a location remote from the beauty facility.” One skilled in the art reviewing claim 37 would understand that the recited steps involve electrical acts or results and require machines or apparatus to perform them. For these additional reasons, claim 37 is directed to statutory subject matter. Accordingly, the § 101 rejection of claim 37 should be reversed.

5. Claims 44, 46, 47, 49, and 59-61

The Examiner alleges that “the steps of ‘*enabling the subject to compare;*’ ‘*determining whether the subject’s cosmetic usage is consistent with . . .*,’ and ‘*analyzing the first and second information*’ could be understood as encouraging a subject to make a certain decision.” Examiner’s Answer at 27.

a) Claim 44

Independent claim 44 recites, among other things, “enabling a beauty facility to record on transportable medium . . . information about a subject,” “enabling the subject to access, at a location remote from the beauty facility, the . . . information,” and “enabling the subject to update, at a location remote from the beauty facility, the . . . information.” As explained above with respect to independent claim 39, recoding, accessing, and updating information on transportable medium require transformation of the information and a machine or apparatus to perform. For at least these reasons, claim 44 is directed to statutory subject matter. Accordingly, the § 101 rejection of claim 44 should be reversed.

b) Claim 46

Independent claim 46 recites, among other things, “enabling a subject to record in a data structure information about the subject’s cosmetic product usage and about the subject’s lifestyle” and “comparing the recorded information with a database of information on cosmetic usage and lifestyle of a plurality of individuals.” As explained above with respect to independent claim 45, recording information in a data structure requires transformation of the information in accordance with rules or structures enforced by the data structure. Moreover, one skilled in the art reviewing claim 46 would understand that the “comparing the recorded information [in a database structure] with a database of information” involves electrical acts or results and requires a machine or apparatus to perform it. For at least these reasons, claim 46 is directed to statutory subject matter. Accordingly, the § 101 rejection of claim 46 should be reversed.

c) Claim 49

Independent claim 49 recites features that are similar to the features recited in independent claim 50. As set forth above with respect to independent claim 50, claim 49 is directed to statutory subject matter. Accordingly, the § 101 rejection of claim 49 should be reversed.

d) Claim 59

Claim 59 depends from independent claim 44. Claim 59 is directed to statutory subject matter for reasons similar to the ones discussed above with respect to independent claim 44. Accordingly, the § 101 rejection of claim 59 should be reversed.

e) Claim 47

Claim 47 depends from independent claim 46. Claim 47 is directed to statutory subject matter for reasons similar to the ones discussed above with respect to independent claim 46. Accordingly, the § 101 rejection of claim 47 should be reversed.

f) Claims 60 and 61

Claims 60 and 61 depend from independent claim 49. Claims 60 and 61 are directed to statutory subject matter for reasons similar to the ones discussed above with respect to independent claim 49. Accordingly, the § 101 rejection of claims 60 and 61 should be reversed.

B. The § 102(e) Rejection of Claim 31 Should Be Reversed

Independent claim 31 recites, among other things, “establishing a subject record, the record including the first image,” “associating the at least one second image with the subject record,” and “providing the subject with viewing access to the subject record.” The Examiner alleges that *Hawkins* inherently discloses the “establishing . . .” and the “associating . . .” features recited in claim 31. Appellants submit that the Examiner has not established inherency with respect to the “establishing . . .” and the “associating . . .” features.

As M.P.E.P. § 2112 makes clear:

To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” (internal citations omitted).

The Examiner alleges that “[w]ithout establishing [a subject] record, . . . the ‘comparing’ step [of Hawkins] simply would not be possible.” Examiner’s Answer at 28. The Examiner alleges that without such a record, a sales representative would not know which images to compare out of a plurality of images from a plurality of consumers. *Id.* Appellants respectfully submit that the Examiner merely suggests probabilities or possibilities. *Hawkins* discloses capturing of a first image and a subsequent later time image. *Hawkins*, however, discloses merely displaying the first image on a monitor and comparing the first and subsequent images without disclosing storing the first image or a subject record. In addition, *Hawkins* fails to even consider the possibility that there may be a plurality of customers simultaneously using the system, or that after capturing a first image of one customer and before capturing a subsequent later time image of the customer, an image of another customer may be captured. Thus, in a scenario considered by *Hawkins*, where there is no interruption by another customer between capturing a first image and capturing a subsequent later time image of one customer, a sale representative may simply compare the subsequent image to a image captured immediately prior to the subsequent image without establishing a record for a subject.

For these reasons, the “comparing” step of *Hawkins* does not necessarily disclose the “establishing . . .” and the “associating . . .” features recited in claim 31. Because the Examiner has not established that *Hawkins* inherently discloses the features and thus a subject record, *Hawkins* also fails to disclose “providing the subject with viewing access to the subject record,” as recited in independent claim 31. Accordingly, the § 102(e) rejection of claim 31 based on *Hawkins* should be reversed.

C. The § 103 Rejection of Claims 46 and 50 Should Be Reversed

1. Claim 46

With respect to independent claim 46, the Examiner alleges that “Maloney teaches while the consumer is initially assigned to an appropriate category of consumers (consistent with the cosmetic usage and lifestyles of a trend of use of at least some of the plurality of individuals), the classifying neural network can *continuously update its decision by incorporating consumer feedback to provide a customized beauty product* to the consumer [and thus suggests] providing the customized product when subject’s cosmetic usage is inconsistent with the cosmetic usage and lifestyles of a trend of use of at least some of the plurality of individual.” Examiner’s Answer at 38. Appellants respectfully disagree.

Maloney merely mentions determining a profiling category for a consumer based on profiling information and providing a list of products corresponding to the category. *Maloney*, pages 7 and 9. Furthermore, even if the Examiner’s allegation were true, a notion that Appellants dispute, *Maloney* suggests providing a customized product based on **consumer feedback** and not when the subject’s cosmetic usage is inconsistent with the cosmetic usage of individual’s with lifestyles similar to the subject’s lifestyle. For at least these reasons, *Maloney* fails to teach or suggest “causing, when the subject’s cosmetic usage is inconsistent with the cosmetic usage of individual’s with lifestyles similar to the subject’s lifestyle, at least one product to be recommended to the subject,” as recited in independent claim 46. Accordingly, the § 103 rejection of claim 46 based on *Maloney* and *Marapane* should be reversed.

2. Claim 50

With respect to independent claim 50, the Examiner alleges that *Hawkins* teaches “capturing an image of a body feature [and] thereby suggests] a step of *establishing a subject record* [because w]ithout establishing [a subject] record, . . . the ‘comparing’ step [of Hawkins] simply would not be possible.” Examiner’s Answer at 35. The Examiner further alleges that without such a record, a sales representative would not know which images to compare out of a plurality of images from a plurality of consumers. *Id.*

As explained above with respect to the § 102(e) rejection of claim 31, *Hawkins* discloses capturing of a first image and a subsequent later time image. *Hawkins*, however, discloses merely displaying the first image on a monitor and comparing the first and subsequent images without disclosing storing the first image or a subject record. In addition, *Hawkins* fails to even consider the possibility that there may be a plurality of customers simultaneously using the system, or that after capturing a first image of one customer and before capturing a subsequent later time image of the customer, an image of another customer may be captured. Thus, in a scenario considered by *Hawkins*, where there is no interruption by another customer between capturing a first image and capturing a subsequent later time image of one customer, a sale representative may simply compare the subsequent image to a image captured immediately prior to the subsequent image without establishing a record for a subject.

For at least these reasons, the “comparing” step of *Hawkins* fails to disclose the “establishing . . .” and the “associating . . .” features recited in claim 50. Because the Examiner has not established that *Hawkins* discloses the features and thus a subject

record, *Hawkins* also fails to disclose “providing the subject with viewing access to the subject record,” as recited in independent claim 50. Accordingly, the § 103 rejection of claim 50 based on *Hawkins* and *Marapane* should be reversed.

II. Conclusion

For the reasons presented in the Appeal Brief, as well as the reasons outlined above, the Board is kindly requested to reverse all of the outstanding claim rejections, so that pending claims 1-25 and 27-61 may be allowed.

To the extent that any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Reply Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
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Dated: December 6, 2007

By: 

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